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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,326	05/25/2001	James Arthur Davis	16,234	5265
23556	7590	07/22/2004	EXAMINER	
KIMBERLY-CLARK WORLDWIDE, INC. 401 NORTH LAKE STREET NEENAH, WI 54956			REICHLER, KARIN M	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/866,326	Applicant(s) DAVIS ET AL.	
	Examiner Karin M. Reichle	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,8-12,15,17,32 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7,13,14,16,18-31 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5-3-04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 3, 4, 8-12, 15, 17, 32, and 34, are still withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

Specification

2. The substitute specification filed 9-8-03 has still not been entered because, e.g., Applicant did not request entry of such in the 5-3-04 response nor do the amendments to the specification on pages 3 and 5 and the abstract filed 5-3-04 comply with 37 CFR 1.121 because they do not show all the changes to the language of the substitute specification to arrive at the proposed language. Even when considering the amendments to page 3 and abstract with regard to the specification existing prior to 9-8-03, such do not comply with 37 CFR 1.121 as they do not show any changes to the preceding language to arrive at the replacement paragraph on page 3 and the changes to the abstract which was previously amended as of 3-17-03. Therefore, the amendments to page 3 and the abstract have not been entered. It is noted that the amendment transmittal letter of 5-3-04 contained uninitialed, undated changes. It is presumed that Applicant was aware of such at the time of signature. Finally, the record is unclear whether a completed copy of the 3-17-03 PTO-1449 accompanied the 6-4-2003 Office action. Therefore, a completed copy of such accompanies this action.

Drawings

3. The drawings were received on 5-3-04. These drawings are not approved by the Examiner. With regard to proposed Figure 5, see discussion in paragraph 2 supra, i.e. the description of Figure 5 was not entered on page 3. Also, a description of the newly added structure 50 and 54 was not provided. Also, entry of such Figure would change the election set forth in Paper No. 3 in which one species was considered the species of Figures 4 and 5.

4. The drawings are objected to because in Figure 5, 32 does not appear to denote a connection means. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the invention as claimed in claims 1-

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2, 5-7, 13-14, 16, 18-31 and 33, i.e. means for connecting which permits the connection of a pumping means, i.e. the bellows, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Description

6. The abstract of the disclosure is objected to because legal terminology, i.e. "means", should be avoided. Correction is required. See MPEP § 608.01(b).

7. The disclosure is objected to because of the following informalities: 1) The Summary of the Invention section, i.e. a description of the claimed invention, and the invention of the claims should be commensurate, see MPEP 608.01(d) and 1302.01, e.g. where in the claims is

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desiccant on the inside of the valving means claimed. 3) In the paragraph bridging pages 12-13, the terminology, i.e. "In the claims...structures." should be avoided, i.e. such describes legal interpretation which is determined by the courts and the legislature. The paragraph set forth in the 3-17-03 response was not entered because it did not comply with 37 CFR 1.121, i.e. the marked up copy and the clean copy do not agree.

Appropriate correction is required.

Claim Objections

8. Claims 30-31 are objected to because of the following informalities: in claim 30, "manual" should be --manually--, "force" should be --forcing--, "draw" should be "drawing" and "means" should be deleted to be accurate. Appropriate correction is required.

Claim Language Interpretation

9. "Personal care product" as claimed in claim 20 and the preambles of claims 28-29, 30-31 and 33 is defined as set forth on page 5, first full paragraph from the bottom. The use of the "means for" phrase in combination with functional language, i.e. means for valving in claims 1-2, 5, and 13, and thereby claims dependent therefrom, means for pumping in claims 6-7, 16, 18 and 19 and thereby the claims dependent therefrom, and means for distributing in claims 28-29, and thereby the claims which depend therefrom, does not invoke 35 USC 112, sixth paragraph, since such phrase and language is modified by sufficient structure, material or acts for achieving the specified function, e.g. a one way valve, piping or tubing, means for manually or mechanically assisting, external bellows, two one way valves. The phrase and language, i.e.

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means for connecting which permits the connecting of a means for pumping in claims 1, 5, 6, and 14, and thereby the claims which depend therefrom, and means for manually or mechanically assisting in claims 6, 14, 16, 18 and 19, does invoke 35 USC 112, sixth paragraph because it is not modified by specific structure, materials or acts for achieving the specified structure. In accord with MPEP 2181 and 2182, the means for connecting are considered to be as defined in the paragraph bridging pages 7-8, page 9, lines 11-12 and 29-31, page 11, lines 6-7 and 12-13, page 11, first full paragraph and paragraph bridging pages 12-13 and Figure 5, i.e. any structure which permits discharge from pumping means to pass into article or product. The means for manually or mechanically assisting passage of air are defined on page 8, first full paragraph, page 9, line 27-page 11, line 6, page 11, line 15- page 13, line 2 and Figures 4-5, e.g. a bellows. It is noted that the functional, capability or property language of claim 30, i.e. "adapted ... pumping", is interpreted as --adapted to be manually or mechanically actuated-- as set forth in the portions cited with regard to the means for manually or mechanically assisting *supra*.

Claim Rejections - 35 USC § 102

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 1-2, 5-7, 13-14, 16, 18-31 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Lau et al '749

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

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102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See Figures 4 and 5 of Lau, i.e. absorbent article or personal care product having a topsheet and backsheet 20, see also col. 3, lines 44-50, valving means or distribution means, e.g. 25 is valve, connection leading thereto is piping, juncture between piping and 21 is connection means, pumping means, i.e. bellows 21, valves 24. Also see abstract, col. 1, lines 56-67, col. 2, lines 10-13, col. 3, lines 18-20, col. 4, lines 4-60, col. 5, lines 7-14, 25-38 and 47-52, col. 6, lines 20-50 and claims. Attention is also directed to Figures 4 and 5 of the instant application. Therefore the Lau reference teaches elements which perform identical function in substantially the same way and produces substantially the same results and/or is the structural equivalent of that set forth in the claims.

Claim Rejections - 35 USC § 103

12. Claims 1-2, 5-6, 14, 16, 20-31 and 33 are directed to an invention not patentably distinct from claims 5-6 of commonly assigned 6,454,749. Specifically, although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of both the application and patent require a "personal care product" as interpreted in light of the descriptions, see portions of patent cited supra, the patent claims require distribution means including piping conveying air from a bellows, i.e. obviously the bellows is a self contained manual assisted pump and there is a structure between the piping and bellows to provide the

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conveying which is a "connection" therebetween and both the claims of the application and patent require distribution of air or air exchange between the wearer's skin and the product(In other words, the application claims are merely broader, i.e. generic to, than the patent claims. Once the applicant has received a patent for a species or a more specific embodiment he is not entitled to a patent for the generic or broader invention. This is because the specific anticipates the broader. The patented claims anticipate the application claims. See *In re Goodman*, 11 F.3d 1046.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned 6,454,749, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 35 U.S.C. 103(c) and 37 CFR 1.78(c) to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Response to Arguments

13. Applicants remarks on pages 7-8 with regard to matters of form have been considered but are either deemed moot in that such matters have not been reraised or deemed not persuasive for the reasons set forth supra. Applicants' remarks on pages 8-9 with regard to the prior art have been considered but are deemed narrower than the claim language which does not require the means for connecting to allow external means to be removably connected. The means for connecting, see claim language interpretation section supra, may include such but it can also be other than that and if the prior art includes any of the materials or structure or their equivalents which correspond to that described by the specification such meets the claim language. The prior art is not required to teach all the materials and structure which correspond to the means as described. Furthermore, Applicant's remarks are narrower than the claims with regard to the elected species of Figures 4-5 as originally filed which does not show the means for connecting as argued.


Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (703) 308-2617. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (703) 308-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Karin M. Reichle
Primary Examiner
Art Unit 3761

KMR
July 20, 2004